

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER T. SCHURMAN

Appeal No. 95-5048
Application No. 08/162,372¹

ON BRIEF

Before CAROFF, METZ, and HANLON, Administrative Patent Judges.

HANLON, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed December 7, 1993.

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 1 and 8-15,² all of the claims pending in the application. The claims on appeal are directed to a blow molded article. Claim 1 is illustrative of the subject matter on appeal and reads as follows:³

1. A blow molded article comprising:

a blow molded, hollow, double walled article having an inner wall and an outer wall substantially parallel to each other and forming a space therebetween, and a connecting wall connecting the inner and outer walls and running substantially perpendicular to the inner and outer walls;

wherein said inner wall has an inner wall face including an edge portion thereof adjacent the connecting wall and a central portion adjacent the edge portion;

at least one essentially U-shaped opening in the inner wall face, said opening being a cut portion of the central portion having components thereof essentially perpendicular to each other, providing access to the space between the inner and outer walls and forming at least one flap member integral

² Claims 4-7 were also finally rejected. However, claims 4 and 5 were canceled in an amendment filed under 37 CFR § 1.116 (Paper No. 6) entered by the examiner, and claims 6 and 7 were canceled in an AMENDMENT AFTER APPEAL (Paper No. 11) also entered by the examiner (see Supplemental Examiner's Answer, p.2).

³ Claim 1 was amended in the AMENDMENT AFTER APPEAL (Paper No. 11) referred to in footnote 2 above.

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with said connecting wall, wherein said flap member is movable towards and away from said outer wall to form a movable separating member spaced from the outer wall, said movable flap member being integrally connected to said edge portion along one side of said flap member by a hinge-like connection permitting movement of the flap towards and away from the outer wall;

wherein said at least one opening in the inner wall face is in the central portion, wherein the flap member is integral with said edge portion; and

wherein said article includes a cover member and a base member complementary to each other and hinged together along a hinge portion wherein said flap member is situated on the cover member and wherein said flap member is integral with said edge portion solely adjacent said hinge portion.

The references relied upon by the examiner are:⁴

Schurman et al. (Schurman)	3,795,265	Mar. 5, 1974
Byrns (Byrns)	4,611,713	Sep. 16, 1986

The following rejections are at issue in this appeal:

⁴ In the "Response to argument" (Answer, pp.5-6), the examiner mentions four additional references. As stated in In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970), "[w]here a reference is relied on to support a rejection, whether or not in a 'minor capacity,' there would appear to be no excuse for not positively including the reference in the statement of the rejection." Since these four references have not been included in the statement of the rejection, we have not considered them in reaching our decision.

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(1) Claims 1 and 8-15 are rejected under 35 U.S.C. § 103 as being unpatentable over Schurman;

(2) Claims 1 and 8-15 are rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Schurman and Byrns;

(3) Claims 1 and 8-15 are rejected under 35 U.S.C. § 112, first paragraph, as containing new matter; and

(4) Claims 1 and 8-15 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Rejection under 35 U.S.C. § 112, first paragraph

Claims 1 and 8-15 are rejected under 35 U.S.C. § 112, first paragraph, as containing new matter. According to the examiner, the phrase "said edge portion solely adjacent said hinge portion" in claim 1 is not supported in the specification as originally filed (Supplemental Examiner's Answer, p.6). Appellant relies on Figures 1 and 4 to establish that the specification, as originally filed, provides support for the invention now claimed. See Vas-Cath

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Inc. v. Mahurkar, 935 F.2d 1555, 1565, 19 USPQ2d 1111, 1118 (Fed. Cir. 1991) ("drawings alone may provide a 'written description' of an invention as required by § 112"). We agree with appellant that Figures 1 and 4 "unambiguously show the connection solely adjacent the hinge portion" (Reply to Supplemental Examiner's Answer, p.4). Therefore, the rejection under 35 U.S.C. § 112, first paragraph, is reversed.⁵

Rejection under 35 U.S.C. § 112, second paragraph

Claims 1 and 8-15 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically (Supplemental Examiner's Answer, p.6):

The recitation of "hinge-like" is unclear to the Examiner's [sic, Examiner] because the phrase hinge-like does not clearly

⁵ The specification has also been objected to under 35 U.S.C. § 112, first paragraph, as failing to provide support for the phrase "said edge portion solely adjacent said hinge portion" (see Supplemental Examiner's Answer, p.6). This objection appears to be moot in view of the reversal of the rejection of claims 1 and 8-15 under 35 U.S.C. § 112, first paragraph.

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recite the physical and/or structural
properties "like" a hinge that the
Appellant intends to claim.

We disagree. Claim 1 further defines the term "hinge-like" as a "connection permitting movement of the flap towards and away from the outer wall." Therefore, one having ordinary skill in the art would have understood the term "hinge-like" as it is used in claim 1 as requiring a connection which permits movement of the flap towards and away from the outer wall. The rejection under 35 U.S.C. § 112, second paragraph, is reversed.

Rejections under 35 U.S.C. § 103

Claims 1 and 8-15 are rejected under 35 U.S.C. § 103 as being unpatentable over Schurman, either alone or in combination with Byrns. The examiner sets forth the grounds of rejection of claims 1 and 8-15 under 35 U.S.C. § 103 based on Schurman alone at pages 3 through 4 of the Answer. Specifically, the examiner recognizes (Answer, p.3):

Schurman et al. discloses a blow molded article that is double walled having inner and outer walls and a space therebetween, a connecting wall between the inner and outer walls running substantially perpendicular (see Abstract). The inner wall has an

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inner wall face including an edge portion adjacent the connecting wall, a central portion adjacent the edge portion (see col. 3, lines 59-65). The article includes cover and base members hinged together along a hinge portion (see col. 4, lines 45-46).

However, the examiner has failed to address the additional limitation in claim 1 of "at least one essentially U-shaped opening in the inner wall face . . . forming at least one flap member integral with said connecting wall, wherein said flap member is movable towards and away from said outer wall"

The examiner bears the initial burden of presenting a prima facie case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). A rejection based on 35 U.S.C. § 103 is premised on the "subject matter as a whole." Having failed to explain how Schurman either describes or renders obvious this additional limitation in claim 1, the examiner has failed to establish how Schurman renders the claimed "subject matter as a whole" obvious under 35 U.S.C. § 103, and therefore, has failed to satisfy his initial burden of presenting a prima facie case of

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unpatentability. For this reason, the rejection of claim 1 under 35 U.S.C. § 103 as being unpatentable over Schurman alone is reversed.

Claims 1 and 8-15 are rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Schurman and Byrns. Byrns discloses a container for carrying a portable tool. The container has a hinged cover formed of a double wall construction and is configured to hold a rotary saw blade. The innermost wall of the double wall construction is provided with a raised portion of generally U-shape (see Figure 2, item 26). According to the examiner, the raised portion is made of a plastic material which suggests that it is movable (Supplemental Examiner's Answer, p.5). To the extent that the examiner thus characterizes the raised portion as a movable flap member, the raised portion is more correctly defined as a "pocket" by virtue of its connection to three sides of the cover. This "pocket" fails to meet the limitations of the flap member in claim 1. See claim 1 ("wherein said flap member is integral with said edge portion solely adjacent said hinge portion"); see also Reply Brief, p.3. Therefore, the

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rejection of claim 1 under 35 U.S.C. § 103 as being unpatentable over the combination of Schurman and Byrns is also reversed.

Claims 8-15 are dependent on claim 1. Since the rejections of claim 1 under 35 U.S.C. § 103 as being unpatentable over Schurman, both alone and in combination with Byrns, have been reversed, the rejections of claims 8-15 under 35 U.S.C. § 103 as being unpatentable over Schurman, both alone and in combination with Byrns, are also reversed. See 37 CFR § 1.75(c) ("Claims in dependent form shall be construed

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to include all the limitations of the claim incorporated by
reference into the dependent claim.").

REVERSED

MARC L. CAROFF)	
Administrative Patent Judge)	
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)	
)	
)	BOARD OF PATENT
ANDREW H. METZ)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
ADRIENE LEPIANE HANLON)	
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APJ HANLON

APJ CAROFF

APJ METZ

DECISION:

Send Reference(s): Yes No
or Translation (s)

Panel Change: Yes No

Index Sheet-2901 Rejection(s): _____

Prepared: July 27, 2000

Draft Final

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OB/HD GAU

PALM / ACTS 2 / BOOK
DISK (FOIA) / REPORT